

151. A process as in Claim 126 further comprising receiving ice pieces delivered  
2 from said source of ice in at least partially bridged condition, and unbridging said ice  
pieces prior to delivering said ice piece into said ice conduit.

### REMARKS

Applicants' attorney wishes to express his appreciation to the Examiner for the latter's courtesy and helpful comments during several recent telephone conversations regarding presentation of an abbreviated claim structure for examination purposes.

In the subject Office Action the Examiner rejected Claims 1-163 under 35 U.S.C. § 112, ¶ 2, in view of 37 C.F.R. § 1.75(b), on the grounds of multiplicity and prolixness. The Examiner required that Applicants elect one of two options for reduction of the number and structure of claims for examination. Applicants have herein provisionally elected the second option, that of two independent claims and no more than twenty claims total. The independent claims are Claims 1 and 126 and all the designated claims, including multiple dependencies, total twenty. The claims are all referred to by their actual numbers, except for Claim 77, which is a provisional composite of Claims 77 and 86. It is believed that forming this composite is properly responsive to the Examiner's requirement of twenty claims, since Claims 77 and 86 are equivalent for search purposes and define, respectively, diverters with multiple outlets and inlets.

Notwithstanding the required designation, Applicants respectfully traverse the rejection for the reasons below.

The Examiner in support of his rejection made reference to Applicants' parent and grandparent applications, Ser. Nos., 09/128,050 and 09/207,075, which, as the Examiner noted, include many of the same claims as are in the present application. Applicants filed those applications as their research on the subject invention progressed. The present application supersedes both the '050 and '075 applications, and those are being expressly abandoned in favor of the present application. Therefore there are no longer any grounds for multiplicity, prolixity or double patenting based directly or indirectly on either of those

applications.

There is no statutory limit in § 112, ¶ 2, on the number of claims an application can contain; *In re Wakefield*, 422 F.2d 897, 164 U.S.P.Q. (C.C.P.A., 1970). The only requirements in Rule 75(b) are that each claim in an application must "differ substantially" from the others in that case and that they must not be "unduly" multiplied. It is submitted that in this case both of those requirements are satisfied.

The Examiner has cited a few examples of pairs of claims that he believes to cover the same subject matter. However, those claims have different dependencies, which makes them cover different subjects. If, as an example, claims 1 and 2 are different, a claim 3 which says "apparatus as in claim 1 comprising X" is not the same as a claim 4 which says "apparatus as in claim 2 comprising X"; *Ex Parte Primich*, 151 U.S.P.Q. 737 (P.T.O.Bd.App., 1966). If the Examiner wishes to maintain his contention that specific claim pairs do not differ from each other, he is respectfully request to identify each pair and state exactly what he believes the identity to be, so that Applicants may address each pair on its own.

That a few pairs or triplets of claims may cover related subject matters does not justify a rejection on prolixity or undue multiplicity. Applicants submit that in the context of this invention and the industry to which it pertains, such differences are significant, are readily understood by those skilled in the art, do not obscure the invention and do not constitute "undue" multiplicity of the claims. The mere fact that there are numerous claims does not constitute legal ground for rejection, unless the examiner can show that the claims are "difficult to understand, [make] examination almost impossible, or ... are for the most part duplicates"; *Ex Parte Birnbaum*, 162 U.S.P.Q. 635 (P.T.O.Bd. App., 1968; *In re Flint*, 411 F.2d 1353, 162 U.S.P.Q. 228 (C.C.P.A., 1969). None of these conditions is present here.

Applicants strongly submit that the claims have not been unduly multiplied, are not prolix, and do not present only insubstantial differences. It is also believed that the number of claims present is appropriate in context; Chisum, CHISUM ON PATENTS, § 3:8.06[4] (1999). It is therefore submitted that the § 112, ¶ 2 rejection is not warranted and should

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be withdrawn.

On the other hand, Applicants accept that the Examiner might believe that examination of all of the claims separately could be burdensome. Applicants have therefore, as the Examiner has called for, elected the claims set forth above as being representative of the overall nature of the invention and of the various elements of the apparatus and process. Applicants have also inserted several "provisional" amendments to conform the dependencies of several of the elected claims to the provisional claim structure represented by these elected claims.

Applicants will consent to the Examiner's searching only these twenty claims if that is done under the following conditions:

1. Applicants and the Examiner agree that all claims continue in the application while the prosecution continues, whether or not those claims are elected, unless specifically cancelled based on prior art, and that the above election does not constitute cancellation of any of the non-elected claims by either Applicants or the Examiner.
2. The results of the search of any elected claim above, any Examiner's Office Action based on that search, and Applicants' response to such Office Action, will all be considered by both the Applicants and the Examiner to be equally applicable to all non-elected claims which depend directly or indirectly from the elected searched claim.
3. The "provisional" amendments made above are solely for the purpose of facilitating the search, and any actual amendments to the elected or non-elected claims, if appropriate, will be made in any response filed by the Applicants in response to any Office Action issued by the Examiner on prior art grounds after completion of the search.

It is believed that this will achieve the desirable result of avoiding any difficulty for the Examiner in conducting an appropriate and thorough search of all principal aspects of the invention, while retaining for Applicants a greater, but appropriate, number of claims to various specific embodiments of each of those aspects which may be found to be



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allowable.

Applicants are also submitting herewith an Information Disclosure Statement which contains art previously cited in the parent and grandparent cases, art newly identified in a search arising from an international counterpart application, and art which Applicants themselves have newly discovered.

### FEES

It is not believed that any fees are due with respect to the amendment of the claims herein. However, should any such fees be due, the Patent and Trademark Office is authorized to charge all such fees to Deposit Account No. 02-4070.

### CONCLUSION

In view of the above amendments and remarks, it is respectfully submitted that the ground of rejection has been avoided and/or traversed, and that representative claims have been identified in response to the Examiner's requirement which will allow for a search from which the Examiner can issue an Office Action on the merits of all major aspects of Applicants' invention.

Should the Examiner believe that prosecution of this application might be expedited by further discussion of the issues, a telephone call to the undersigned attorney, collect, at the telephone number listed below. is cordially invited.

Respectfully submitted,

Date: July 13, 2000

By: \_\_\_\_\_

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